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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,404	11/13/2003	Stephan S. Porter	47168-00245USPT	9907
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NIXON PEABODY LLP 161 N. CLARK STREET 48TH FLOOR CHICAGO, IL 60601-3213			EXAMINER WILSON, JOHN J	
			ART UNIT 3732	PAPER NUMBER
			MAIL DATE 06/01/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/713,404

Applicant(s)

PORTER ET AL.

Examiner

John J. Wilson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16-57, 67 and 69-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14, 16-28, 36-38, 45, 52-54, 67 and 69-71 is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-13, 29-35, 39, 44, 46-51 and 55-57 is/are rejected.
- 7) ☒ Claim(s) 7 and 40-43 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 8, 11, 29, 31-35 and 46-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Schiel et al (5993213). Schiel shows an implant, Fig. 4, proximal end as shown, interior bore as shown, and anti-rotation cavity 15. To call the top half of 15 a first anti-rotation cavity, the middle portion a spacing portion and the bottom half of 15 a second anti-rotation cavity is merely terminology and/or intended use. The second anti-rotation cavity has a diameter no greater than the first as shown. As to claim 8, see first axial retention section 19 distal of the second anti-rotation cavity. As to claims 22 and 35, the first and second anti-rotation cavities are inherently capable of mating with an abutment and driving tool. As to claims 46 and 50, the intended use of the shown structure with abutments and the type of abutments are merely matters of intended use, and as such, are not given patentable weight.

Claims 29-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Rogers (5984680). Rogers shows an implant 10, Fig. 7b, table 14, first non-round anti-rotation feature 24 adjacent to the table and second non-round anti-rotation feature 22 adjacent to the first and located further from the table than the first. As to claim 35, the show structure is capable of functioning as claimed. The actual intended function is given no patentable weight.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiel et al (5993213) in view of Kownacki et al (5302125). Schiel shows the structure as described above, however, does not show a recess. Kownacki shows a recess 77, Fig. 8, above a threaded section 26. It would be obvious to one of ordinary skill in the art to modify Schiel to include a recess of Kownacki in order to better hold the device to the implant.

Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiel et al (5993213) in view of Niznick (5061181). Schiel does not show a driving tool. Niznick shows a driving tool, Fig. 3D, column 4, lines 35-39. It would be

obvious to one of ordinary skill in the art to modify Schiel to include a driving tool as shown by Niznick in order to drive the implant into the bone.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schiel et al (5993213) in view of Gittleman (2002/0127515). Schiel shows an implant, Fig. 4, proximal end as shown, interior bore as shown, and anti-rotation cavity 15. To call the top half of 15 a first anti-rotation cavity, the middle portion a spacing portion and the bottom half of 15 a second anti-rotation cavity is merely terminology and/or intended use. The second anti-rotation cavity has a diameter no greater than the first as shown. Schiel does not show using first and second abutments. Gittleman shows a first a first abutment 65, Fig. 3, having a non-locking portion 63 and a locking portion 57, and shows a second abutment 6, Fig. 2, having a locking portion 9. The implant and abutments are merely listed in the claims and not structurally tied together. It would be obvious to one of ordinary skill in the art to modify Schiel to include the abutments as shown by Gittleman because the list of elements is properly met by listing the same elements shown in prior art. The manner in which the elements may be used or adapted to be positioned together is merely intended use.

Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schiel et al (5993213) in view of Gittleman (2002/0127515) as applied to claims 36 and 39 above, and further in view of Niznick (5061181). The above combination does not show a driving tool. Niznick shows a driving tool, Fig. 3D, column 4, lines 35-39. It would be

obvious to one of ordinary skill in the art to modify the above combination to include a driving tool as shown by Niznick in order to drive the implant into the bone.

Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schiel et al (5993213) in view of Niznick (5061181). Schiel shows an implant, Fig. 4, proximal end as shown, interior bore as shown, and anti-rotation cavity 15. To call the top half of 15 a first anti-rotation cavity, the middle portion a spacing portion and the bottom half of 15 a second anti-rotation cavity is merely terminology and/or intended use. Schiel does not state how the implant is inserted in the bone. Niznick shows using torque by way of a driving tool, Fig. 3D, column 4, lines 35-39, for engaging a polygonal feature, Fig. 3D. It would be obvious to one of ordinary skill in the art to modify Schiel to include the step of using a driving tool as shown by Niznick in order to drive the implant into the bone.

Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schiel et al (5993213) in view of Broberg et al (6280195). Schiel shows an implant, Fig. 4, proximal end as shown, interior bore as shown, and anti-rotation cavity 15. To call the top half of 15 a first anti-rotation cavity, the middle portion a spacing portion and the bottom half of 15 a second anti-rotation cavity is merely terminology and/or intended use. Schiel does not show selecting an abutment from a plurality of abutments. Broberg teaches selecting the abutment from a plurality of abutments, column 5, line 65 through column 6, line 5. It would be obvious to one of ordinary skill in the art to modify Schiel to include using an abutment and to include the step of selecting the abutment from a

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plurality of abutments as shown by Broberg in order to better match the abutment with the needs of the patient.

Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schiel et al (5993213) in view of Broberg et al (6280195) as applied to claim 55 above, and further in view of Niznick (5061181). The above combination teaches the steps described above, however, does not state how the implant is inserted in the bone. Niznick shows using a driving tool, Fig. 3D, column 4, lines 35-39, for engaging an anti-rotation feature, Fig. 3D. It would be obvious to one of ordinary skill in the art to modify Sutter to include the step of using a driving tool as shown by Niznick in order to drive the implant into the bone.

Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schiel et al (5993213) in view of Broberg et al (6280195) as applied to claim 55 above, and further, in view of Kumar (6217332). The above combination does not show removing the drive tool and implant from a package. Kumar teaches removing a drive tool 119 and implant 120 for a package. It would be obvious to one of ordinary skill in the art to modify the above combination to include using a package as shown by Kumar in order to improve convenience and hygiene.

Allowable Subject Matter

Claims 14, 16-28, 36-38, 45, 52-54, 67 and 69-71 are allowed.

Claims 7 and 40-43 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

With respect to the prior art to Rogers ((5984680), even though Rogers teaches that it is known in the art to have posts or sockets interchangeable between the implant and an abutment, if one of ordinary skill in the art were to change the location of the shown elements, the implant would still have only one polygonal feature as shown in Fig. 3. Further, there is not teaching or suggestion that the same taught advantages of tightening the elements together would work if the two polygonal post were inverted into an internal bore. As such, the above claims are held to be patentable over Rogers.

Response to Arguments

Applicant's arguments filed April 3, 2007 have been fully considered but they are not persuasive. The rejected claims, as amended, merely apply names to an already shown structure as indicated above, and therefore, do not patentably distinguish there over.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Wilson whose telephone number is 571-272-4722. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez, can be reached at 571-272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

***/John J. Wilson/
Primary Examiner
Art Unit 3732***

jjw
May 25, 2007